REMARKS

Claims 2-5, 7-8, 10-14, 20-28, 35-38, 40-41, 43-47, 53-58, 68-71, 73-74, 76-80 and 86-88 are pending in the application. Claims 11, 26, 44 and 77 have been amended. Support for the amendment can be found throughout Applicant's Specification (e.g., page 6, line 21 through page 7 line 10).

Claims 2-5, 7-8, 11-14, 20-28, 35-38, 40-41, 44-47, 53-58, 68-71, 73-74, 77-80 and 86-88 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leak et al. (US 6,182,072 B1) ("Leak") in view of Chen et al. (US 6,625,624 B1) ("Chen"). For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference of combine references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicant respectfully submits that the combination of references suggested by the Examiner does not teach "a method for providing resources from a Web server to a client computer, the method comprising: receiving a single request at a Web server from a client computer, the single request identifying a desired Web page; generating a site map at the Web server based on the single request, the site map including the desired Web page; ... and sending an archive file containing the site map to the client computer in response to the single request," as recited in Claim 11.

The Examiner stated in the Advisory Action that Leak teaches that the "client system 1 uses the identified URI to request and receive each of the Web pages that are directly linked to the current Web page (i.e., the second Web pages) (col. 7, lines 40-43)." The Examiner further states that this step also corresponds to the step of "generating a site map." Applicant submits that this is not the same as "receiving a single request at a Web server from a client computer" and "generating a site map at the Web server based on the single request," as recited in Amended Claim 11. For at least this reason, Claim 11 is patentable over Leak in view of Chen.

The Examiner has also stated that Leak does not specifically teach "sending an archive file containing the site map to the client computer in response to the single request," as recited in Claim 11. The Examiner suggests that this limitation is taught by Chen at Col. 4, lines 1-62. Applicant respectfully disagrees and submits that Chen does not teach this feature. Chen does not send "an archive file ... to the client computer in response to the single request" "from the "client computer" as recited in Claim 11. Further, Chen does not cure the deficiencies stated above in reference to Claim 11. Because all of the elements of Claim 11 are not taught or suggested by the combination of Leak in view of Chen, Claim 11 is patentable.

Even if Leak in view of Chen taught all of the elements of Claim 11, there would be no motivation to combine Leak and Chen in the manner suggested by the Examiner. Applicant respectfully submits that the Examiner cannot establish obviousness by locating references which describe various aspects of a patent Applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent Applicant has done. *Ex parte Levengood*, 28, USPQ2d 1300, 1302 (Bd.Pat.App.Int., 1993). References may not be combined indiscriminately. It is not enough for a valid rejection to view the prior art in retrospect once an Applicant's disclosure is known. The art applied should be viewed by itself to see if it fairly disclosed doing what an Applicant has done. *In re Skoll*, 187 USPQ 481, 484 (CCPA, 1975) (citing *In re Schaffer*, 108 USPQ 326, 328-29 (CCPA, 1956)). "The test for an implicit showing [of obviousness] is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved ***as a whole*** would have suggested to those of ordinary skill in the art." (Emphasis added). *In re Kotzab*, 217 F.3d 13645, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

The Examiner suggests that it would have been obvious to one skilled in the art to combine Leak and Chen to "enable users to retrieve and search through old information, even after such information has evolved or disappeared from the original server." Chen teaches archiving services, but does not teach or suggest a displayable tour, or sequence, of web pages. Leak does not teach or suggest any concern with, or appear to recognize any advantages of, an archiving service for displaying a tour, or sequence of web pages on a client machine. Applicant traverses the Examiner's suggestion that there is any

motivation to combine Leak and Chen in the manner suggested by the Examiner. In arriving at an absence of any teaching to combine the References, one skilled in the art does not arrive at the claimed invention. In view of the foregoing, Applicant submits that no motivation can be found in either of the References to combine the technologies of the References to arrive at the claimed invention, and that the Examiner has improperly combined the References since there is no evidence of a motivating force which would impel one skilled in the art to do what the patent Applicant has done. Accordingly, Applicant respectfully requests reconsideration and withdrawal of these rejections.

For at least the above reasons, Claim 11 is patentable over Leak in view of Chen. Because they depend from Claim 11, Claims 2-5, 7-8, 10, 12-14, 20-25 and 86 are patentable for the same reasons that Claim 11 is patentable. Because they contain similar limitations, Claims 26, 44 and 77 are patentable over Leak in view of Chen for the same reasons advanced above for Claim 11. In addition, because they depend from Claim 26, Claims 27-28 are also patentable. Because they depend from Claim 44, Claims 35-38, 40-41, 43, 45-47, 53-58 and 87 are patentable for the same reasons that Claim 44 is patentable. Because they depend from Claim 77, Claims 68-71, 73-74, 76-80 and 88 are patentable for the same reasons that Claim 77 is patentable.

Claims 10, 43 and 76 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leak in view of Chen and further in view of Becker (U.S. Patent No. 5,937,411) ("Becker"). Because Claim 10 depends from Claim 11 it is patentable for at least the reasons described above in reference to Claim 11. Because Claim 43 depends from Claim 44 it is patentable for at least the reasons described above in reference to Claim 44. Because Claim 76 depends from Claim 77 it is patentable for at least the reasons advanced above with respect to Claim 77.

In view of the foregoing remarks, Applicant submits that the above-identified application is now in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance be issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event that the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicant's attorney hereby authorizes that such fee be charged to Deposit Account 09-0463, maintained by Applicant's attorneys.

Respectfully submitted,

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